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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,872	07/21/2003	Ai Kondo	56232.90	5889
7590	09/09/2004		EXAMINER	
Squire, Sanders & Dempsey L.L.P.			MCCLENDON, SANZA L	
Suite 300			ART UNIT	
One Maritime Plaza			PAPER NUMBER	
San Francisco, CA 94111			1711	

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/623,872	Applicant(s) KONDO, AI	
	Examiner Sanza L McClendon	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-10, 12 and 13 is/are rejected.
- 7) ☒ Claim(s) 4 and 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/04</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed March 22, 2004 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because copies of the foreign patent documents were not submitted with the IDS. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Claim Rejections – 35 USC § 102/35 USC §103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3 and 6-9 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hiwara et al (6,166,100).

Hiwara et al teaches cationically polymerizable-pigmented compositions. Said compositions comprising (A) a cationically polymerizable binder component and (B) a cationic polymerizing initiator capable of initiating polymerization by irradiation or heat, and (C) a color pigment. The binder component contains at least one resin or compound selected from the group consisting of (A-1) a cationically polymerizable acrylic resin consisting of a copolymer of (a) a (meth) acrylic ester monomer, (b) a polymerizable unsaturated monomer containing polymerizable groups and at least one cationically polymerizable moiety selected from the group consisting of an epoxy group and an oxetane ring, and, optionally, (c) other polymerizable unsaturated monomer, and (A-2) a fatty acid modified epoxy compound containing an aliphatic hydrocarbon group and epoxy group. Said compound (A-1) contains epoxy groups and/or oxetane groups in amounts from 2 to 100 on average per one molecule. In addition, Hiwara et al teaches the composition may contain other cationically polymerizable compounds (A-3) as an optional component. A-3 may include epoxy compounds, vinyl compounds, bicycloorthoester compounds, spiroorthocarbonate compounds, and oxetane compounds, preferably epoxy and oxetane compounds are used from the standpoint of physical properties and curing properties. In the first embodiment of the Hiwara et al composition comprises a composition containing (A-1) and (A-3) in amounts from 10-90% by weight of (A-1) and 10-90% by weight of (A-3), as well as, the cationic initiator (B) and colored pigment (C). The initiator compound (B) includes cationic polymerization initiators that form an acid capable of initiating cationic polymerization upon exposure to radiation or heat. This anticipates claim 6. Other initiators can be found in

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column 14. The colored pigment may include a white pigment, such as titanium white, zinc oxide, and the like. This is deemed to anticipate claim 8-9. Said pigment can be found in amounts from 1-500 parts by weight in the composition. This amount appears to anticipate at least one of applicant's amounts in claim 7. Applicant's instant invention of claims 1-3 appear to be anticipated by Hiwara et al because Hiwara et al teaches compositions comprising an oxetane containing compound (A-1) in amounts from 10 to 90% by weight, wherein 65-90% anticipate the instant claims, a white pigments (titanium dioxide) in amounts from at least 1-500 parts by weight or in amounts of at least 22% by weight as seen in example 1 (Table 1), and an epoxy compound and/or vinyl ether compound (A-3).

The examiner deems the limitation "for ink-jet recording" appears to be merely a functional limitation does not add a positive limitation to the claim, it provides only for the ability of the ink to function as an ink composition for ink-jet recording. Since the prior art teaches the instantly claimed composition it is deemed to be able to function in the same capacity.

5. Claims 1-2, 5-6, 8-9 and 12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Watanabe et al (6,783,840).

Watanabe et al teaches resist ink compositions comprising a compound (a) having at least one oxetanyl group and at least one epoxy group in the same molecule and a compound (b) capable of initiating cationic polymerization under irradiation by active energy rays and/or heat. Said compound (b) once exposed to irradiation and/or heat generates an acid capable of initiating the cationic polymerization, also called an acid generator. In addition to (a) and (b) the composition can comprise a compound (c) having at least one epoxy and no oxetane groups in the molecule, a compound (d) having at least one oxetanyl groups and no epoxy groups, a compound (e) having at least one radical polymerizable group in the molecule, a photo-racial polymerization compound (f), and a alkali-soluble compound (g). Compound (b) can be found in amounts from 1 to 20 parts by mass, per 100 parts by mass of the blended amount of compound (a). Compound (c) can be found in amounts from 10 to 500 parts by mass, per 100 parts by mass of compound (a). Compound (d) can be found in amounts from 5 to 200 parts by mass, per 100 parts by mass of (a). Compound (e) can be found in amounts from 5 to 500 parts by mass, per 100 parts by mass of (a). Compound (f) can be used in amounts from 0.007 to 0.5 moles, based on 1 equivalent amount of the polymerizable groups in (e). Compound (g) can be found in

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amounts from 5 to 2000 parts by mass, per 100 parts by mass of (a). Watanabe et al teaches that said composition can be solventless—see column 10, lines 46-47. This is deemed to anticipate claim 12. In addition, said composition can be comprise other adjuvant, such as colorants, wherein titanium dioxide is listed—see column 11, line 24. Per example 7, Watanabe et al teaches an ink composition comprising an (a) epoxy/oxetane compound, (b) an acid generator, (c) an epoxy compound, (d) an oxetane compound, (e) an acrylate compound, (f) a free radical polymerization initiator, (g) an alkali soluble resin, a sensitizer, a filler, and a colorant, wherein it is deemed that a white pigment is exchangeable with the green pigment to prepare a white instead of green ink. This is deemed to anticipate claims 1-2, 5-6, and 8-9.

The examiner deems the limitation “for ink-jet recording” appears to be merely a functional limitation does not add a positive limitation to the claim, it provides only for the ability of the ink to function as an ink composition for ink-jet recording. Since the prior art teaches the instantly claimed composition it is deemed to be able to function in the same capacity, especially since Watanabe et al teaches said composition can be applied by spray and electrostatic coating methods.

Claim Rejections – 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 10 and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiwara et al (6,166,100).

Hiwara et al is described in an above rejection. Hiwara et al does not expressly teach a substantially solventless composition, using an organic white pigment, or the ink having a

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viscosity as defined in claim 13. Hiwara et al discloses that said composition can be cured by irradiation and goes on to disclose in the case where a solvent is used, irradiation is preferably carried out after the solvent has been removed. The examiner deems that one of ordinary skill in the art using said disclosure at the time of invention would have been able to determine that a solvent is optional and not necessary to prepare said ink composition as taught by Hiwara et al in the absence of evidence to the contrary and/or unexpected results. With regards to claim 13, the Patent and Trademark Office is not equipped to conduct experimentation in order to determine whether Applicant's composition differs and, if so, to what extent, from the discussed reference. Therefore, with the showing of the reference, the burden of establishing non-obviousness by objective evidence is shifted to the Applicants. In the alternative it would have been within the ability of an ordinarily skilled artisan to determine a suitable viscosity, such as found in claim 13, for coating a substrate with said ink composition as taught by Hirawa et al. The motivation would have been to obtain an ink coating composition with good color development properties and good flowability in the absence of unexpected results and/or evidence to the contrary. Hirawa et al does not expressly teach using organic white pigments, however Hirawa et al teaches using inorganic and organic colored pigments. Therefore the examiner deems that an artisan of ordinary skill in the art at the time of the invention could have chosen an organic white pigment for use in the composition as taught by Hirawa et al, motivated by such things, as cost-effective reasons and/or accessibility to said pigments in the absence of unexpected results and/or evidence to the contrary.

Allowable Subject Matter

8. Claims 4 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter: The limitation of claims 4 and 11 are not expressly taught and/or fairly suggested in an ink composition as defined in claim 1.

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Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanza L McClendon whose telephone number is (571) 272-1074. The examiner can normally be reached on Monday through Friday 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sanza L McClendon

Examiner

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